REMARKS

By this amendment: (1) claim 1-6 are cancelled without prejudice; and (2) claims 21 and 22 are rewritten in independent form.

This application now contains claims 7-15, 17-29 and 31. In view of the above amendments and the remarks hereinafter, it is respectfully requested that this application be reconsidered.

Claims 1-6 have been cancelled to remove the objection under 35 U.S.C. 112.

The rejection of claims 11-12 under 35 U.S.C. 102(b) as being anticipated by Boon is respectfully traversed. Claim 11 recites "a casing at least partly encasing the control housing and the pressure pad". Boon does not disclose a casing that at least partly encases a control housing. The pressure pad and casing as shown in FIG. 1 of Boon is electrically connected through the external cable 40 to the control unit. This is more clearly shown in FIG. 3 in which the control unit is shown with an integrated circuit at 58 and the casing is shown at 10 with the two being interconnected by the cable 40. Claim 12 depends from claim 11 and avoids a rejection under 35 U.S.C. 102(b) for the same reason. For a claim to be anticipated by a reference, the reference must show each and ever claimed feature.

The rejection of claims 7 - 10 under 35 U.S.C. 102(a) as being anticipated by Stroda is respectfully traversed. Stroda is not a proper reference under 102(a) since this application has the same priority date for all of the information disclosed in Stroda. Accordingly, the citation of Stroda does not provide a *prima facie* case that the material was known or used by others in this country, or patented or described in a printed

publication in this or a foreign country before the invention. The Examiner has the burden of proof under 35 USC 102(a) and this has not been satisfied.

The rejection of claims 13-15 and 26-27 under 35 U.S.C. 102(3) as being unpatentable over Boon in view of Stroda is respectfully traversed. It is assumed that the Examiner meant the rejection to be under 35 U.S.C. 102 or 35 U.S.C. 103 although there appears to be a typographical error causing it to be written in a slightly different format, "35 U.S.C. 102(3)", but since there is no section of the statute that is 35 U.S.C. 102(3), it is assumed that it was intended to be 35 U.S.C. 102 or 35 U.S.C. 103. It is clear from the Examiner's language after that recitation that the Examiner concedes there is no rejection under 35 U.S.C. 102 since the Examiner has specifically stated that Boon does not disclose some of the claimed recitations.

The Examiner has not shown that Stroda is prior art against this application. Stroda has the same filing date as this application thus preventing the Examiner from relying on 35 U.S.C. 102(a), (b) or (d) to establish prior art, 35 U.S.C. 102(e), (f) and (g) are precluded by 35 U.S.C. 103(c) and obviously 35 U.S.C. 103(c) does not apply. Thus the rejection under 35 U.S.C. 103 does not apply since it relies on a reference that the Examiner has not shown to be prior art.

The rejection of claims 17-20 under 35 U.S.C. 102 or 35 U.S.C. 103 as being unpatentable over Boon in view of Smith III is respectfully traversed. Title 35 U.S.C. 102 cannot be applied to a rejection of claims as being unobvious over one reference in view of another. It must only be anticipated by a single reference. Accordingly, it is assumed that the Examiner relies on 35 U.S.C. 103.

Assuming the Examiner intended to reject claims 17- 20 under 35 U.S.C. 103 as being unpatentable over Boon in view of Smith, this rejection is also traversed. It is not obvious to a person of ordinary skill in the art to reject two parts of a combination merely on the ground that those two parts exist in the prior art. There must be some suggestion or teaching that would cause a person of ordinary skill in the art to combine the teachings of Boon and the teachings of Smith or a *prima facie* case of obviousness has not been made out. In this case, there is no suggestion or teaching that would cause one to include the gel pad of Smith into the pad of Boon. Each of these two disclosures is entirely independent and serve a complete function by themselves while the function of the combination claims 17-20 is not taught at all.

Moreover, it is not proper to reject the claims with the mere statement that it would be obvious to avoid faults by not activating the alarm until a predetermined time has passed in the absence of a teaching that is not found in the patent application itself. A claim cannot be rejected on the ground that the inventor in the same application has disclosed the feature or the advantage of the feature. There must be an outside prior art teaching that false alarms will be reduced or some logic indicating such a reduction in false alarms would occur. In this case, there is no such prior art teaching and the delay period would be unobvious to a person of ordinary skill in the art.

The rejection of claims 21, 22, 23 and 28 under 35 U.S.C. 103(a) as being unpatentable over Boon in view of Stroda and Triplett et al, is respectfully traversed. Firstly, the Examiner has not established that Stroda is prior art to this application. Secondly, neither Triplett nor Boon disclose the steps of:

"disposing of the pressure pad when the patient no longer has use of the pressure pad without permitting use by another patient.".

The Examiner has failed to establish a *prima facie* case showing that such limitations would be obvious to a person of ordinary skill in the art. It is not adequate to merely repeat an advantage that is given in the application specification itself to indicate that it would be obvious. There must be some external evidence indicating obviousness and there is no such external evidence presented by the Examiner. Accordingly, the Examiner has not established a *prima facie* case.

Moreover, neither Boon nor Triplett disclose a voice message nor a photoelectric sensor nor has the Examiner relied on any teaching that would make them obvious. The allegation that a voice message is conventional in the absence of prior art fails to create a *prima facie* case. The Examiner has the burden of showing the prior art exists or providing another reason why it is obvious and citing Stroda does not do either of these since Stroda has the same priority date as this application.

Claim 23 includes the recitations:

"activating an alarm when the pressure above said predetermined pressure has been on the pressure pad for a predetermined time and is removed from the armed pressure pad after said predetermined time; and

disposing of the pressure pad when the patient no longer has use of the pressure pad without permitting use by another patient;

wherein... and a voice message is announced near the patient wherein the step of placing said second sensor in juxtaposition with the first sensor includes the substep of detecting the direction of motion of the patent.".

Neither Triplett nor Boon disclose these features nor is there any indication in the Examiner's argument that they are disclosed in the prior art. Moreover, no reason is given why they would be obvious to a person of ordinary skill in the art. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness.

Similarly, claim 28 recites "a casing at least partly encasing the control housing and the pressure pad". Neither Triplett nor Boon disclose this feature. Accordingly, the Examiner has failed to establish a *prima facie* case of unpatentability of those claims. A *prima facie* case is not established by merely asserting that the missing elements in the prior art are obvious. There must be some logical reason based on fact causing them to be obvious and no such reason has been given by the Examiner.

Since each of the claims now in this application defines patentably over each of the cited references and every combination of the cited references and since the claims are proper and definite, it is respectfully requested that they be allowed and this application be passed to issue.

Respectfully submitted,

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